

3D Shape Marks and Public Interest. The Boundary between Functional and Aesthetic Design. Stormy Weather ahead for Design Products?

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3D shape marks are worth fighting for in the world of trade marks; soap tablets for washing machines, car grills, electric shavers, forklift trucks, torches, wristwatches, ice cream desserts have been and will be the subject of questions to and answers of the European Courts. The producers of these products are fighting fiercely to keep the 3D shape of their products marks or get them registered.

Almost sixteen months ago the European Court of Justice rendered its decision regarding the 3D shape of the famous *Philishave*.¹ Remington claimed victory, but did it win? Can shapes of products that achieve a technical result not be registered as a trade mark, because it is in the public interest that these shapes should be freely available for all, or are there other options?

Ten months later, the European Court of Justice rendered another decision with respect to 3D shape of product marks.² In the three joined cases (*Linde/Winward/Rado*), the questions of the German Bundes Gerichtshof were answered with respect to the shapes of a forklift truck, a torch and a wristwatch. The Court ruled clearly that in the assessment of the distinctiveness of the 3D shape of a product mark a stricter test than that used for other types of trade marks should NOT be applied. However, the public interest does have to be taken into account in the assessment.

Will this public interest rationale provide the Trademark Offices a tool to refuse applications for 3D shapes of products marks? We shall further examine whether stormy weather awaits us.

Philips/Remington

The *Philishave*, Philips' revolutionary three-headed rotary shaver, the latest model of which was used by **007** in the latest Bond film, was introduced in Europe in the mid-sixties. The design of the head of the shaver – the three circular heads with rotating blades in the shape of an equilateral triangle – was filed as a trade mark in the United Kingdom in 1985.³ Philips filed similar trade mark applications in other countries, such as Germany, France, Italy, Sweden, Spain and Australia.

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In 1995, Remington commenced the sale of the *DT 55*, a shaver with a shape similar to that of the *Philishave*. Displeased by that similarity, Philips invoked its shape trade mark rights on the basis of its 3D shape trademark in the United Kingdom.⁴

Remington, however, responded by filing a counterclaim. Remington claimed that Philips' shape trade mark should be revoked, because the mark was incapable of distinguishing the goods concerned from those of other undertakings (Art. 3(1)(b) of the Directive⁵). In addition it lacked distinctive character (Art. 3(1)(c)). Finally, Remington argued that the shape trade mark allegedly consisted exclusively of a sign, which served in trade to designate the intended purpose of the goods, and of a shape, which was necessary to obtain a technical result, and/or which gave substantial value to the goods (Art. 3(1)(e)).

The High Court of Justice of England and Wales, Chancery Division (Patents Court) allowed Remington's counterclaim and ordered Philips' trademark registration to be revoked. Philips appealed to the Court of Appeal (England and Wales), which stayed the proceedings in order to refer seven questions to the European Court of Justice, as the parties interpreted Art. 3(1)(e)(ii) of the Directive differently.

Art. 3(1)(e)(ii) states:

The following shall not be registered or if registered shall be liable to be declared invalid:

e) signs which consist exclusively of:

(ii) the shape of goods which is necessary to obtain a technical result.

Necessary: 'result-directed principle' or 'appliance-directed principle'

The parties' had differing views on the meaning of the word 'necessary' in this provision. Philips' interpretation of the word necessary was based on the 'result-directed principle', which means, in this case, that if there are alternative shaver shapes available that could achieve the same technical result – a certain standard of shaving performance – and if those differently shaped shavers could be produced at the same cost, the restriction of Art. 3(1)(e)(ii) would not apply. If there were alternative shapes, the shape of the *Philishave* would not be necessary to obtain a technical result. Since the word 'necessary' is used in the second indent of Art. 3(1)(e), Philips argued that the result-directed principle should be applied rather than the 'appliance-directed principle', which Remington put forward. Remington argued that

notwithstanding alternative shapes that could achieve the same technical result, trade mark rights could not protect the shape of the Philips shaver. That shape was necessary to obtain the technical result concerned, i.e. shaving.

The fourth of the seven questions referred to the European Court of Justice dealt with this difference of opinion. The Court answered only the first four questions.

The first three questions

The first three questions were:

'1. Is there a category of marks which is not excluded from registration by Article 3(1)(b), (c) and (d) and Article 3(3) of Council Directive 89/104/EEC which is nonetheless excluded from registration by Article 3(1)(a) of the Directive (as being incapable of distinguishing the goods of the proprietor from those [of] other undertakings)?

2. Is the shape (or part of the shape) of an article (being the article in respect of which the sign is registered) only capable of distinguishing for the purposes of Article 2 if it contains some capricious addition (being an embellishment which has no functional purpose) to the shape of the article?

3. Where a trader has been the only supplier of particular goods to the market, is extensive use of a sign, which consists of the shape (or part of the shape) of those goods and which does not include any capricious addition, sufficient to give the sign a distinctive character for the purposes of Article 3(3) in circumstances where as a result of that use a substantial proportion of the relevant trade and public

- (a) associate the shape with that trader and no other undertaking;
- (b) believe that goods of that shape come from that trader absent a statement to the contrary?'

With references to its *Loendersloot*, *Canon* and *Windsurfing Chiemsee* decisions⁶ the Court considered that there is no class of marks having a distinctive character by their nature, or by the use made of them, that is not capable of distinguishing goods or services within the meaning of Art. 2 of the Directive.⁷ The Court subsequently answered the first question in the negative.⁷

With respect to the second question, the Court first reminded us that the main function of trade marks is to distinguish the product or service from others. Secondly it noted that Art. 2 does not distinguish between different categories of trade marks. Subsequently, the criteria for assessing the

distinctive character of a shape trade mark do not differ from other trade marks. The Court finally observed that the Directive does not require that the shape of the product must include some capricious addition and that a shape must simply be able to distinguish. The answer to the second question was straightforward; the shape of a product does not require any capricious addition, such as an embellishment that has no functional purpose.⁸ Fortunately, the Court adhered to the basic principles. If the Court had affirmed the question, shape of product marks would have had to meet an extra and different criterion than other kinds of trade marks. Moreover, the next topic of debate would have been what is a 'capricious addition' and how capricious does the addition have to be in order to distinguish.⁹

Before answering the third question, to remove all doubt the Court observed that secondary meaning (pursuant to Art. 3(3)) could not serve the shape of a product that is refused on the grounds of Art. 3(1)(e). The Court then answered as follows:

'that, where a trader has been the only supplier of particular goods to the market, extensive use of a sign which consists of the shape of those goods may be sufficient to give the sign a distinctive character for the purposes of Article 3(3) of the Directive in circumstances where, as a result of that use, a substantial proportion of the relevant class of persons associates that shape with that trader and no other undertaking or believes that goods of that shape come from that trader. However, it is for the national court to verify that the circumstances in which the requirement under that provision is satisfied are shown to exist on the basis of specific and reliable data, that the presumed expectations of an average consumer of the category of goods or services in question, who is reasonably well-informed and reasonably observant and circumspect, are taken into account and that the identification, by the relevant class of persons, of the product as originating from a given undertaking is as a result of the use of the mark as a trade mark.'¹⁰

The answers to these three questions actually confirm the notion that 3D shape of product marks do not require different treatment than other trade marks, such as word marks and 2D marks. In addition, national courts have to use the same criteria to assess secondary meaning, even if only one trader has marketed the product concerned.

The fourth question

'(a) Can the restriction imposed by the words 'if it consists exclusively of the shape of goods which is necessary to achieve a technical result' appearing in Article 3(1)(e)(ii) be overcome by establishing that there are other shapes which can obtain the same technical result or

(b) is the shape unregistrable by virtue thereof if it is shown that the essential features of the shape are attributable only to the technical result or

(c) is some other and, if so, what test appropriate for determining whether the restriction applies?'

The ECJ rephrased the fourth question as follows:

'By its fourth question the referring court is essentially asking whether Article 3(1)(e), second indent, of the Directive must be interpreted to mean that a sign consisting exclusively of the shape of a product is unregistrable by virtue of that provision if it is established that the essential functional features of the shape are attributable only to the technical result. It also seeks to know whether the ground for refusal or invalidity of the registration imposed by that provision can be overcome by establishing that there are other shapes which can obtain the same technical result.'

After three prefatory remarks¹¹, the ECJ states clearly, with reference to its *Windsurfing Chiemsee* decision¹² that 'all the various grounds listed in Article 3 of the Directive must be interpreted in the light of the public interest underlying each of them'.¹³

In the *Windsurfing Chiemsee* decision the Court stated that 'Article 3(1)(c) pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the categories of goods or services in respect of which registration is applied for may be freely used by all'.¹⁴

The Court went on to expound on the public interest. In the view of the Court, 'the rationale behind the grounds for refusal of 3D trade marks is to prevent trade mark protection from granting a proprietor a monopoly on technical solutions or functional characteristics of a product that a user is likely to seek in the products of competitors'.¹⁵

The Court emphasizes in the same paragraph that since the function of a trade mark is to distinguish a product or service from those offered by competitors, the restrictions of Art. 3(1)(e) are to prevent trade mark protection from being extended beyond that. In other words, it is not in the public interest and thus not the objective of trade mark rights to monopolise 'technical solutions and functional characteristics of a product that a user is likely to seek in the products of competitors'.¹⁶

In paragraph 79 the Court gets to the core of Art. 3(1)(e), second indent, by stating:

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'that provision is intended to preclude the registration of shapes whose essential characteristics perform a technical function, with the result that the exclusivity inherent in the trade mark right would limit the possibility of competitors supplying a product incorporating such a function or at least limit their freedom of choice in regard to the technical solution they wish to adopt in order to incorporate such a function in their product.'

Given 'the legitimate aim', as the Court calls it,¹⁷ that it is not in the public interest to monopolise technical results (or functions) and that such results (or functions) may be freely used by all¹⁸, the Court's subsequent answer is just plain logic.

The Court decided in no uncertain terms that 'as to the question whether the establishment that there are other shapes which could achieve the same technical result can overcome the ground for refusal or invalidity contained in Art. 3(1)(e), second indent, there is nothing in the wording of that provision to allow such a conclusion.' The 'result-directed principle' based on the word 'necessary' in the second indent of Art. 3(1)(e)(i), defended by Philips, therefore went by the board.¹⁹

In paragraph 84 the Court answers the fourth question:

'In the light of those considerations, the answer to the fourth question must be that Article 3(1)(e), second indent, of the Directive must be interpreted to mean that a sign consisting exclusively of the shape of a product is unregistrable by virtue thereof if it is established that the essential functional features of that shape are attributable only to the technical result. Moreover, the ground for refusal or invalidity of registration imposed by that provision cannot be overcome by establishing that there are other shapes which allow the same technical result to be obtained.'

The question remains what do the words 'essential functional characteristics', 'attributable only to' and 'the technical result' mean.

Essential functional characteristics

The words 'essential functional characteristics' cannot be found in Art. 3(1)(e)(ii). We learn from the decision that the referring Court of Appeal used the words 'essential features' in the fourth question. The Court, however, rephrased that question and uses the words 'essential functional characteristics' instead. Later, the Court refers twice to 'technical solutions or functional characteristics of a product which a user is likely to seek in the products of a competitor',²⁰ Thereafter, the Court uses the phrase 'shapes whose essential characteristics perform a technical function',²¹

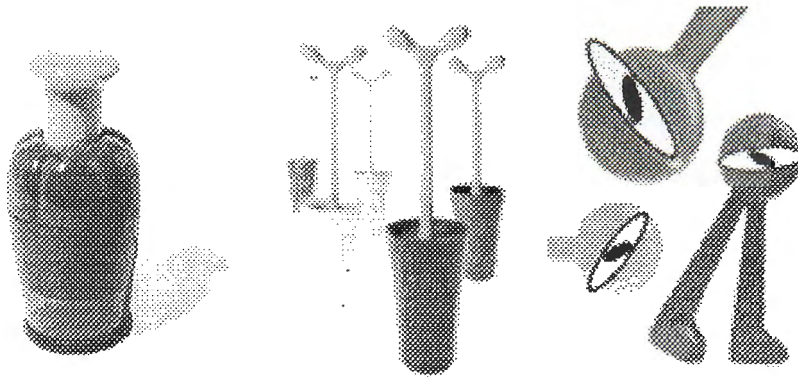
Essential functional characteristics:

- are characteristics or features of a shape;
- must perform a technical function, in other words they have to be functional;
- and finally those functional characteristics must also be essential.

Consequently, characteristics of a shape of a product that do not perform a technical function, or are not functional – and thus a capricious addition (?!) – or are not essential, may not be taken into account.

'attributable only to'

What do the words 'attributable only to', used by The Court, mean? Does that mean that if the essential functional characteristics of the shape of the product can be attributed to the technical result, such as the shapes of Alessi²² vegetable choppers, toilet brushes and tin openers, these shapes can be barred from registration. Or does it mean that if the essential functional characteristics of the shape are attributable only to the technical result, the shapes can be barred.



Let us bear in mind that Art. 3(1)(e)(ii) does not use the words 'attributable only to', but the words 'which consist exclusively of'. The referring Court of Appeal used the words 'attributable only to' in its question 4(b). The Court copied those words in the rephrased fourth question. In paragraph 79, the Court first observes that 'shapes whose essential characteristics perform a technical function, with the result that (...)'. In that phrase the Court does not refer to characteristics that are 'attributable only to' or 'consist exclusively of'. Later on in paragraph 83, in connection with its choice for the appliance-directed principle, the Court uses the words 'attributable solely'. Both synonyms 'only' and 'solely' mean "no one or nothing more besides".⁴⁵

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It can be argued that the essential characteristics of these Alessi designs are all needed to achieve a technical result, or that their essential characteristics perform a technical function, i.e. to chop vegetables, to clean a toilet and to open a tin. Without the circled knife and the handles of the tin opener (essential characteristics) to push and hold the circled knife in place (technical function) and the knob (essential characteristic) the tin cannot be opened (technical function). Can the shape of this tin opener not be protected by trade mark right? That would seem far-fetched.

If a shape whose essential functional characteristics are only (solely, exclusively or merely) designed to perform the technical functions, then the shape must be barred, even if these characteristics are pleasing to the eye.²⁴

If not, that 'would limit the possibility of competitors supplying a product incorporating such a function or at least limit their freedom of choice in regard to the technical solution they wish to adopt in order to incorporate such a function in their product', as the Court stated in the key paragraph.²⁵

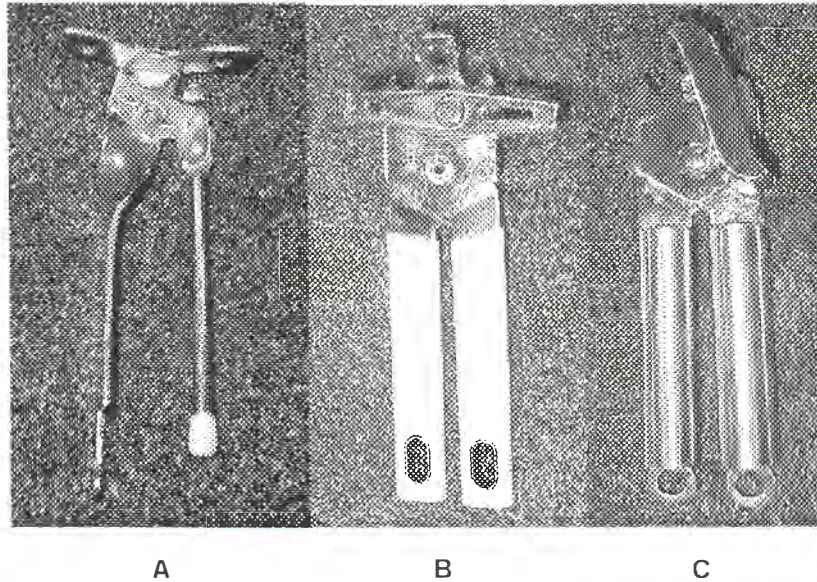
Therefore, it could be argued that the boundary lies between (i) simple straightforward shapes, which must be barred - even if they are pleasing to the eye or distinct from other shapes -, and (ii) shapes which demonstrate that more attention has been paid to the aesthetic design of the essential functional characteristics than was essential (necessary) to achieve a satisfying functional performance. The latter shapes could be registered.

It may be argued that, if the boundary lies there, that could turn out to be a disadvantage. A small degree of aesthetic design could be awarded with endless trade mark protection, which carries the inherent risk that the technical result will be monopolised. That risk, however, should not be avoided by moving the boundary. The scope of trade mark protection depends on the distinctive power of the trade mark. Consequently, another producer could also use the technical result, but would have to give the freely available essential functional characteristics of the shape of product another aesthetic design element.

There is no reason to worry that aesthetical design elements lacking in distinctiveness will be rewarded, as the provisions of Article 3(1)(b) and (c) are there to bar the registration of shapes that are devoid of any distinctive character, and which consist exclusively of 'descriptive' signs.

Arguably, the 'public interest' rationale for keeping technical solutions free from trade mark protection refers to (basic or elementary) shapes needed to (i.e. essential to) obtain a technical result and which have not been subject to some degree of aesthetic design. With respect to the following tin openers,

the boundary could be placed between B and C, but even tin opener C might not exceed the boundary.



Concurrence with copyrights and design rights

Many may argue that if the above were correct that would mean that designed product shapes could be granted trade mark protection that is endless and therefore provides protection that goes far beyond the terms of protection provided by the design rights and copyrights. That is true, but only if the shape of the product also meets the other criteria of a trade mark, i.e. it is distinctive, it is not descriptive et cetera. In the case of other types of trade marks, such as 2D marks, concurrence may arise with other intellectual property rights. For example, a print design for a shopping bag can be protected by copyrights, design rights and trade mark rights, as long as it meets the relevant criteria.

If the shape of a product meets the other criteria and can therefore serve as a trade mark and it does not restrict others from using the essential functional characteristics needed to perform a technical function, it should be granted trade mark protection.

If for reasons of public interest or other reasons it is not acceptable that shapes of products do not deserve trade mark protection, trade mark

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legislation should be changed. However, in the European Union a choice was made to protect shapes of products with trade mark rights, but not to further restrict the protection for shapes of products in comparison with other kinds of trade marks, nor to exclude them from trade mark protection.

'the technical result'

That leaves us with the term 'technical result'. Given the 'public interest' rationale, it seems that the term 'technical result' is a very broad term indeed for all kinds of technical or functional results achieved by a technique. It does not matter whether the technique is sophisticated or simple, nor is the nature of the technique decisive. It can be mechanical, electrical, chemical, digital, et cetera.

So who won, Philips or Remington?

The fact that it is possible to use other shapes to achieve the same technical result did not help Philips. Given the views of the courts in the United Kingdom, Remington would be home free in there.²⁶ On the other hand, if Philips could demonstrate that the shape mark does not consist solely of essential functional characteristics, because for example its triangular shape is not essential or functional, it might be on the right track.

After the decision, Remington claimed victory. On its website it read '*Remington wins Landmark Trade Mark Case.*'²⁷ The BBC opened with the header '*EU Legal Setback for Philips*'.²⁸ The headlines were right, at least in the United Kingdom. The Court of Appeal (England and Wales) (Civil Division) that referred the questions to the European Court of Justice rendered its final decision on 9 April 2003, in which it revoked Philips' trade mark.²⁹

In the meantime, however, in Germany the Landgericht (Court) of Cologne granted a preliminary ruling in favour of Philips, prohibiting Remington from selling its triple-headed rotary shavers. Last May, the Court of Appeal of Cologne (Oberlandesgericht) upheld the preliminary injunction.³⁰ Consequently, following Court decisions, Remington has won one battle in the United Kingdom and Philips has won one battle in Germany.³¹ However, who will win the war in Europe is still unclear. The war wages on in France, Spain and Italy.

Linde/Winward/Rado

After the *Philips/Remington* decision the Court of Justice delved into the next case concerning product shapes. By referral of the German

Bundesgerichtshof (Federal Court of Justice) the Court was requested to answer two questions with respect to Art. 3(1)(b) and (c) of the Directive. The three joined cases involved applications for 3D shape of product marks for a forklift truck, a torch and a wristwatch. The German Patent and Trade Mark Office refused all three applications for lack of distinctive character. With respect to the latter application the Office also stated that there was a need to preserve availability.

The two questions were:

'(1) In determining whether a three-dimensional trade mark which depicts the shape of a product has a distinctive character within the meaning of Article 3(1)(b) of the Directive is there a stricter test for distinctive character than in the case of other forms of trade marks?'

'(2) In the case of three-dimensional trade marks which depict the shape of the product, does Article 3(1)(c) of the Directive have any significance independently of Article 3(1)(e)? If so, when considering Article 3(1)(c) – or alternatively Article 3(1)(e) – must regard be had to the interest of the trade in having the shape of the product available for use, so that registration is, at least in principle, ruled out, and is possible as a rule only in the case of trade marks which meet the requirements of the first sentence of Article 3(3) of the Directive?'

With respect to the first question regarding the distinctive character of a 3D shape of product mark the Court stated – with references to the *Philips/Remington* case – that:

'neither the scheme of the Directive nor the wording of that provision indicates that stricter criteria than those used for other categories of trade marks ought to be applied when assessing the distinctiveness of a three-dimensional shape of product mark.'³²

The trademark offices are not permitted to set other, let alone stricter, tests for 3D shape of product marks in the assessment of the distinctiveness under Art. 3(1)(b). The applicants for these trade marks could breath again, but the hurdle of Art. 3(1)(c) was next.

With regard to the second question, the Court of Justice first observed that if the preliminary obstacle of Art. 3(1)(e) has been overcome, Art. 3(1)(c) also applies for 3D shape of product marks.³³

Referring to the second limb of the second question, the Court states that 'the various grounds for refusing registration set out in Art. 3 of the Directive

should be interpreted in the light of the public interest underlying each of them'. As set forth above, the Court used the 'public interest' rationale for the first time in its *Windsurfing Chiemsee* decision, and it was brought up again in the *Philips/Remington* decision, both in the light of Art. 3(1).³⁴

In the Court's view Art. 3(1)(c) also pursues an aim that is in the public interest, namely all may freely use descriptive signs or indications relating to the characteristics of goods and services in respect of which registration is applied for.³⁵

The Court continues that 'the competent authority (...) must determine, by reference to the goods or services for which registration is sought, in the light of a concrete consideration of all relevant aspects of the application, and in particular the public interest referred to above, whether the ground for refusing registration in that provision applies to the case at hand.'³⁵

In addition, the decision of the Court makes clear that the competent authority (a Trade Mark Office) may not refuse an application without concrete examination. On the other hand, when it performs an examination it must take the public interest into account.³⁷ The burden of proof seems to be on the competent authority, and in the event of a revocation action, on the party that states that the shape of the product is descriptive. In my view the same applies to Art. 3(1)(e), although it is ultimately up to the national courts.

In this decision the Court again refers to the public interest to clarify the objective of the absolute ground for refusal of Art. 3(1)(c). The Court decides on the one hand that the competent authority may not use stricter rules under Art. 3(1)(c) for 3D shape of product mark applications and that the competent authority is obliged to examine the shape of the product. On the other hand, it explains that the public interest dictates that product shapes that consist exclusively of signs or indications that may serve to designate the characteristics of the goods or service (...) should be freely available to all and cannot be registered.

The same terms were used in the *Philips/Remington* decision. Hopefully, the Court meant that if a shape of a product consists exclusively (solely) of basic characteristics – 'elementary elements' in the words of the German Patent and Trademark Office – it cannot serve as a trade mark, as these basic or elementary characteristics should be kept free for everybody. Again, this means that if the shape of a product consists of more than basic characteristics, it can serve as a trade mark, provided it meets all the other criteria of Art. 3(1).

Conclusion

Are the applicants and owners of 3D shape marks treated unfairly in comparison to the applicants and owners of other trade marks? Is there any hope for applicants of 3D shape of product marks or do they face stormy weather ahead?

No, the applicants and owners of 3D shape marks are not treated unfairly, not even in comparison to the applicants and owners of other trade marks. As the Court stated in both decisions the same criteria apply to 3D shape of product marks as to other kinds of trade marks. In other words, the criteria for the former are not different or stricter than those for the latter, and do not stipulate as necessary such requirements as 'capricious additions'.

Yes, there is hope. First, no additional criteria have been set. Furthermore, the borderline lies somewhere between functional design and aesthetic design. Art. 3(1)(e)(ii) still leaves room for shapes of products in which the design of the essential functional characteristics goes beyond the boundaries of solely functional design. How far beyond those boundaries it has to go and how much attention to aesthetical design must be paid has yet to be determined. Time will tell, but a design element, for example a capricious addition, could help clear the technical result hurdle.

Finally, in all the cases, it seems to be up to the competent authority or revoking party to demonstrate that the shape of the product only designates the characteristics of the good or that its essential functional characteristics are only attributable to the technical result.

Stormy weather is ahead for shapes of products and trade marks that fall short of the boundaries of basic elements. However, the coast is clear for the trade mark applicants and owners of shapes of products that do go beyond the boundaries of basic elements in their products.

The line between functional and aesthetic design is in essence a line between public interest and public interest. It is in the public interest to keep the characteristics that belong to the public domain freely available, such as essential functional characteristics and descriptive elements, but it is also in the public interest to protect distinctive product shapes that can serve as trade marks, so the public will be able to distinguish the product from others of a different origin.³⁸

Therefore, it would amaze me, if the shape of VIENETTA ice cream would melt down to basic, elementary ice cream in the hands of the European Court of Justice.³⁹

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End Notes:

- ¹ *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd* (Case C-299/99, ECJ, 18 June 2002).
- ² *Linde AG, Winward Industries Inc. and Rado Uhren AG* (Cases C-53/01, C-54/01 and C-55/01, ECJ, 8 April 2003).
- ³ In the UK the registration of 3D trade marks became possible after the introduction of the 1994 Trade Marks Act. Philips had to file the shape trade mark in those days as a 2D shape trade mark, as it was impossible to file a 3D shape of products mark.
- ⁴ Cases between Philips and Remington have been initiated in Germany, Sweden, France, Spain and Italy.
- ⁵ First Council Directive of 21 December 1988 to approximate the laws of the Member States relating to trade marks, 89/104/EEC.
- ⁶ *Loendersloot* (Case C-349/95, ECJ, 11 November 1997). *Canon* (Case C-39/97, ECJ, 29 September 1998); *Windsurfing Chiemsee Produktions- und Vertriebs GmbH* (Case C-107/97, ECJ, 4 May 1999)..
- ⁷ Paragraphs 29-40.
- ⁸ Paragraphs 47-50.
- ⁹ A different view has L. Lochner, *Functional shape marks: the European Court of Justice gives the thumbs down*, Trade Mark World, Augustus 2002, p. 16-19.
- ¹⁰ Paragraphs 57-65.
- ¹¹ Paragraphs 73-75.
- ¹² Paragraphs 25-27 of *Windsurfing Chiemsee*, see note 6.
- ¹³ Paragraph 77.
- ¹⁴ Paragraph 25 of *Windsurfing Chiemsee*, n. 6.
- ¹⁵ Paragraph 78.
- ¹⁶ It is still doubtful whether the ECJ also accept other functions than the function guarantee of origin, such as the functions of quality and reputation. Although the Court noted in the *Arsenal v Reed* decision, *Arsenal Football Club plc v Matthew Reed* (Case C-206/01, ECJ, 12 November 2002) that the mark was a badge of support for or loyalty or affiliation to the trade mark proprietor rather than a perception that the mark acted as a guarantee of origin.
- ¹⁷ Paragraph 82.
- ¹⁸ Unless the technical result is protected by patent rights or other rights.
- ¹⁹ See also paragraphs 31-41 of Advocate General Ruiz-Jarabo Colomer's Opinion of 23 January 2001, in which he makes a distinction between the rationales of the similar restrictions in the Trade Mark Directive and Council Regulation (EC) No 6/2002 of 12 December 2001 on Community Designs

20 Paragraph 78.
21 Paragraphs 79 and 80.
22 Designed by Stefano Giovannoni of Alessi, see
23 www.alessi.com/designers/giovannoni/index.htm.
24 See for example Concise Oxford Dictionary, 2001 and the American Heritage Dictionary
(online at www.bartleby.com).
25 Some essential functional straightforward, simple or basic designs can please the eye,
26 but they are in essence functional.
27 Paragraph 79.
28 The High Court and the Court of Appeal had both already concluded that the registered
29 3D shape of Philips was void.
30 See www.remington-products.com/usa/corpinfo/pr/pr20020618.html.
31 See <http://news.bbc.co.uk/1/hi/business/2051572.stm>.
32 According to Philips' IP department.
33 Landgericht Cologne, 9 September 2002 and Oberlandesgericht Cologne, 9 May 2003.
34 According to Philips the Courts decided that as the trademark had been upheld by the
35 German Patent and Trademark Office in a cancellation action by Remington, the trade
36 mark was still valid. Remington has appealed the decision.
37 Earlier Philips has won in Sweden and Remington in Australia.
38 Paragraph 46.
39 Paragraphs 65 - 68.
Paragraph 71,
Paragraph 73.
Paragraph 75.
Paragraph 76.
The essential function of a trademark, according the Court of Justice; see paragraph 30
of the *Philips/Remington*-decision
The High Court in the United Kingdom is going to refer the *VIENETTA* ice cream case to
the European Court of Justice; see *Just desserts? Vienetta case fails to clarify shape
marks confusion*, Emma Hanson, Trademark World, February 2003.